

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Niculo STEINRISSER Group Art Unit: 3679
Appln. No. : 10/598,011 Examiner: Nahid Amiri
Filed : August 15, 2006 Confirmation No.: 9108
For : TOOTH PROFILE OF A SPLINE SHAFT

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Examiner's restriction requirement of May 28, 2009, the period for response extending until June 29, 2009 (as June 28, 2009 is a Sunday), Applicant hereby elects the invention of Group I, including claims 12 – 22, 24 – 26, 30 and 31. Moreover, the above election is made with traverse for the reasons set forth herein below.

In the restriction requirement of May 28, 2009, the Examiner indicated that all pending claims (12 – 22 and 24 – 31) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including claims 12 – 22, 24 – 26, 30 and 31, drawn to a groove profile for a positive hub-shaft connection, classified in class 403, subclass 359.1; and into Group II, including claims 27 – 29, drawn to a method of producing the groove profile, classified in class 29, subclass 557.

Applicant respectfully submits that the restriction requirement is *per se* improper. Applicant notes that the instant application is a U.S. National Stage Application filed under 35

U.S.C. § 371. As such, in accordance with MPEP § 1893.03(d), Applicant respectfully submits that the proper test for requiring a restriction is unity of invention under 37 C.F.R. § 1.475.

Thus, Applicant respectfully submits that the restriction requirement is *per se* improper, as the Examiner has not addressed unity of invention. Moreover, as claims 27 – 29 depend from claim 12, Applicant submits that there is unity of invention between the Examiner-designated Groups I and II.

Accordingly, should the Examiner wish to maintain the restriction requirement, Applicant respectfully submits that the Examiner must address the restriction requirement under the unity of invention standard. Moreover, Applicant requests the Examiner provide detailed reasons or explanations in support of the restriction based upon the specifics of this application. Otherwise, the restriction requirement should be withdrawn and all claims 12 – 22 and 24 – 31 should be examined.

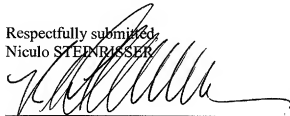
It is Applicant's position that there is unity of invention between the Examiner-designated Groups I and II, and that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I and II.

Thus, for the above-noted reasons, the Examiner's restriction is believed to be improper. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement in this application.

Nevertheless, Applicant has elected, with traverse, the invention defined by Group I, i.e., claims 12 – 22, 24 – 26, 30 and 31, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Nicolo STEINRISER



Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191